

ground. The terminal disclaimer indicates the conflicting U.S. Patent is commonly owned with this application.

Claims 11-19 were pending prior to this Amendment.

Claim 11 has been amended to more particularly point out and distinguish applicants' invention over the references of record.

Claims 11-19 are presently pending for the consideration of the Examiner.

A clean version of the entire set of pending claims is enclosed in accordance with 37 CFR 1.121 (c) (3).

A clean version of the entire specification is enclosed in accordance with 37 CFR 1.121 (b).

Applicant's independent claim 11 has been amended to avoid an obvious double patenting rejection over claim 1-18 of applicants' U.S. Patent No. 6,385,928. Applicants' amended independent claim 11 of the above-identified application now requires an inner continuous cavity adapted to receive a plurality of strands and that the sheath have a low coefficient of friction. These features are not claimed in claims 1-18 of U.S. Patent No. 6,385,928. In contrast claims 1-18 of U.S. Patent No. 6,385,928 claim other structural elements which are not present in claims 11-19 of the above-identified application e.g. recesses which extend in a helical fashion (independent claims 1 and 6, U.S. Patent 6,385,928), a pressure-equalizing medium (independent claims 8, 11 and 15, U.S. Patent 6,385,928), the tension member (independent claims 11 and 16, U.S. Patent No. 6,385,928).

Claim 11 as amended of the above-identified application now requires that the spacing elements define an inner continuous cavity adapted to receive a plurality of strands. In particular, amended claim 1 of the above-identified application now expresses the feature that the spacers form a continuous cavity. This cavity accommodates the strands.

In Nutzel each strand is contained in its own separate cavity. This makes the tension member far more expensive. The tension member of Nutzel will also be less bendable and thus has to be reeled on a substantially larger reel. This last feature has no substantial consequences in the application of Nutzel, since it is used as tendon for concrete. Thus the tendons have relatively short lengths.

In the applications envisaged in the present application, the length may be several hundred meters and possibly also more than one thousand meters. The transportation of

this tension member is vital for the application. The ability to reel the tension member on a relatively small diameter will reduce the transport costs vastly.

According to the present invention the tension member is made far simpler, since the strands are enclosed in the same cavity. The spacers act to keep the integrity of this cavity and ensure that the cross sectional area is large enough for the strands to move lengthwise.

In Shields there are also spacers between each strand. In addition the spacers act with force on the strands, effectively preventing these from moving lengthwise. This is diametrically opposite from the object of the present invention.

A prior patent is a reference only for what it clearly discloses or suggests; it is improper use of a patent as a reference to modify it to that which it does not suggest; *In re Hummer*, 113 USPQ 66 (CCPA 1957). See also *In re Stencel*, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987).

Dependent claims 12-19 are directly or indirectly dependent upon applicants' amended independent claim 11 and, therefore, require all the structural features and limitations of applicants' amended independent claim 11, as well as other structural features and limitations, which in combination are not described in Nutzelt and Shields.

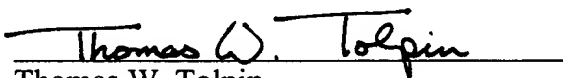
It is submitted that it would not be an obvious matter of choice for one skilled in the art to reconstruct Nutzelt, Shields and the other references to achieve applicants' invention as recited in applicants' claims without the benefit of hindsight of applicants' disclosure and such is clearly improper. As the Federal Circuit Court of Appeals (formerly the U.S. Court of Customs and Patent Appeals) has emphasized, the Examiner must be ever alert not to read obviousness into an application on the basis of applicants' own statements and must further view the prior art without reading into that art applicants' teachings, *In re Spinnoble*, 405 F. 2d 578, 160 USPQ 273 (CCPA 1969). It is not enough for a valid rejection of the patent application to view the prior art in retrospect; once applicants' disclosure is known, the prior art should be viewed by itself to see if it fairly discloses what the applicants have done, *In re Schaffer*, 220 F. 2d 476, 108 USPQ 326 (CCPA 1956).

In summary, an improved tension member is recited in the amended claims of the above-identified application which is not anticipated or obvious from the references of record. Advantageously, applicants' improved tension member is particularly beneficial for tension leg platforms used in drilling and production in oil fields, as well as for other uses.

Inasmuch as the preceding amendment complies with the Examiner's requests, cures the Examiner's objections and patentably distinguishes applicants' remaining claims over the cited prior art references of record, it is respectfully submitted that the above-identified application is now in condition for allowance. A Notice of Allowance is respectfully requested.

The Examiner is invited and encouraged to contact the undersigned attorney in order to expedite this application to allowance, if the preceding does not already place the above-identified application in condition for allowance.

Respectfully submitted,


Thomas W. Tolpin
Registration Number 27,600
Attorney for Applicants

Address:

Welsh & Katz, Ltd.
22nd Floor
120 South Riverside Plaza
Chicago, Illinois 60606
Phone: (312) 655-1500